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REMARKS

Applicants thank the Examiner for the consideration given the present application. Claims 1-18 are pending, of which claims 1, 10, 12, and 17 are independent. Claims 1, 2, 9, and 10 are amended for clarity. Claim 1 is further amended to recite that the method can be performed with a pre-existing network. Claim 2 is further amended for consistency with claim 1. Claim 10 is further amended to eliminate a temporal limitation. Claim 12 is amended to include the subject matter of claim 13, which is cancelled. Claims 12, 14, and 15 are amended to cover any type of music source and player, not just an mp3 player. Claims 16-18 are added to afford Applicants with the protection to which they are deemed entitled.

Applicants traverse the objection to claims 1, 4, 6, 10, and 15.

The word "authorisation" is not an informality requiring correction; it is a British spelling. As stated in MPEP 608.01, "Examiners should not object to the specification and/or claims in patent applications merely because applicants are using British English spellings (e.g., colour) rather than American English spellings. It is *not* necessary to replace the British English spellings with the equivalent American English spellings in the U.S. patent applications."

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Applicants traverse the rejection of claims 1-5 and 10 under 35 U.S.C. §102(e) as being anticipated by Rautila et al. (U.S. 6,549,625).

Applicants challenge the assertion in the Office Action that because "the user pays for a service and position transmitter acknowledges it, it is inherent that mobile device makes a request for permission for the transfer for the required data." First, it is not completely clear what is intended by "position transmitter," since Rautila identifies no such structure. Second, a proper basis for inherency has not been established.

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the

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Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

As a matter of law, the Examiner must show that mobile device 12 of Rautila necessarily requests permission from the IP network including database 26, via long-range link 42, for the transfer of the required data from some other element within broadcast area 18 to short-range transceiver 44 of mobile terminal 12. A careful reading of the passage relied on in the Office Action fails to indicate that Rautila discloses a request for permission transmitted by network transceiver 46 via link 42 to the IP network including database 26. As a matter of law, the Examiner must explain how Rautila inherently provides authorization for the transfer of the required data from a device within broadcast area 18 to the short-range transceiver 44 of mobile terminal 12 in response to mobile terminal 12 receiving authorization from the IP network including database 26. The Examiner must also show that the authorization is necessarily transmitted from the network including database 26 to network transceiver 46 of mobile device 12 via link 42.

The relied-upon portion of Rautila only discusses the flow of information between the IP network including database 26 and network transceiver 46 via link 42 and states:

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The information which is broadcast via the link 24 is diverse in nature and includes identification information. The information which is broadcast by at least one position transceiver 14 includes without limitation advertisements, information relating to making emergency calls, information relating to providing navigation services to enable a user of the mobile terminal 12 to move from a first position to a second position, information for calibrating a position of the mobile terminal 12 within a cellular network providing connection to the network transceiver therein or for calibrating the network positioning determination function, information relating to location and location based devices or services 25 which are proximate to the broadcast location and the mobile terminal from which the user of the mobile terminal receives goods or services after communication of the mobile terminal with a database within IP network including servers with database 26, such as printing a document by a closest available printer, information informing a user of the special services, such as telecommunications available only at the location of the position transceiver with the advertisement information including a price of goods or services and a requested form of payment indication with the user sending with the mobile terminal the requested form of payment to the database using a short message system (SMS) format and the network transmitting acknowledgment of payment 27 from the database to the position transmitter 14 and the position transmitter transmitting the acknowledgment 27' of payment to the user of the mobile terminal and access 27'' location based device or specialized service 25 or to machine 27''' providing the purchased goods or receiver.

Clearly, there is nothing in the above passage of Rautila relating to permission or authorization. Accordingly, claim 1 is not anticipated by Rautila.

Claims 2-5 depend on and are allowable with claim 1. With respect to claim 2, the Office Action inaccurately states that Rautila discloses a service provider that transmits provisional permission, together with a costing, to the first transceiver of

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the first communications device. First, there is no disclosure by Rautila of provisional permission. Second, the service provider in the network including database 26 does not appear to transmit to mobile device 12 permission of any type. Instead, at column 7, lines 5-7, Rautila indicates there is a transmission from the IP network including database 26 to broadcast location 16 (see column 7, lines 5-7). However, mobile device 12 is not at, but communicates with, broadcast location 16 via a wireless link.

Concerning claim 3, Applicants cannot agree that Rautila discloses the requirement for the first communication device to communicate a message accepting the costing to the service provider using the first transceiver. There is no disclosure of accepting costing at column 6, line 48, through column 7, line 10, as alleged in the Office Action.

With respect to claim 4, the Office Action fails to establish the proper basis for an inherency rejection. The Office Action contends Rautila discloses a service provider that issues an authorization once acceptance of the costing is received from the first communication device. However, the Examiner must provide rationale, not merely assert, that column 6, line 48, through column 7, line 10, inherently includes the requirements of claim 4. A mere assertion is insufficient.

The rejection of claim 10 based on Rautila is also incorrect, *inter alia*, because the Office Action fails to provide

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the necessary rationale for the statement that "Rautila further teaches that the mobile terminal placing inherently an order for the intended purchase with the supplier using its second transceiver when payment authorisation is received from the payment facility." (Presumably, the Office Action intends to say that Rautila inherently teaches mobile terminal 12 places an order for an intended purchaser with a supplier in broadcast area 18 using its short-range transceiver 44 when payment authorization is received by network transceiver 46 from the IP network including database 26. However, a reference cannot "inherently teach"; a reference either teaches or discloses a particular feature, or the feature is inherent in the subject matter disclosed. Further, the requisite rationale has not been provided to show that network transceiver 46 receives a payment authorization from the IP network including database 26.

Applicants traverse the rejection of claims 6 and 7 as being unpatentable over Rautila in view of Ramachandran et al. (U.S. 2001/0044747).

Applicants cannot agree that Rautila discloses that short-range transceiver 44 of mobile device 12 communicates with any other device within broadcast area 18 to inform such a device within broadcast area 18 that mobile device 12 has received authorization to communicate with that other device. The Examiner is requested to explain how the relied-upon portion of

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Rautila (column 6, line 48, through column 7, line 10) discloses such authorization from the IP network including database 26.

Ramachandran does not disclose the claim 6 requirement for a short-range transceiver of a mobile communication device informing a second communication device to download the required data. In Ramachandran, output device 18 of automatic teller machine (ATM) 10 can supply sound files, including MP3 files, to a portable computing device, such as Diamond Rio, that is connected to port 18. Communication between port 18 and the Diamond Rio can be by way of a Bluetooth link, i.e., a wide-band, short-range link. When the portable computing device is connected to port 18, ATM 10 can be operative for a fee to download sound files, i.e., downloading occurs in response to a fee being deposited in the ATM. There is no disclosure in Ramachandran of a transceiver of the Diamond Rio or other similar device requesting the ATM to perform the downloading.

For at least these reasons, claims 6 and 7 are not obvious from Rautila in view of Ramachandran.

Applicants traverse the rejection of claims 8 and 9 as being unpatentable over Rautila in view of Hitchings, Jr. (U.S. 6,594,484).

Hitchings does not cure the deficiencies previously noted with respect to the rejection of claim 1, upon which claims 8 and 9 depend. In addition, in rejecting claims 8 and 9, the Office Action equates Hitchings list of scripts with the required data

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files. However, column 2, lines 11-14, indicates each of the scripts includes a sequence of previously saved user input interactions associated with accessing a particular service provided by an automated telephone information service. Applicants cannot understand how the scripts can be equated with the required data files of claims 8 and 9 and courteously request an explanation.

Applicants also cannot agree that one of ordinary skill in the art would have combined Hitchings' automated access by a mobile device to automated telephone services with the Rautila system, which includes a broadcast area 18 including mobile terminal 12, broadcast location 16, vending machine 27'', and other possible devices. According to the Office Action, motivation for the modification is to produce user input interactions with an information access system, but Applicants are at a loss to understand exactly what is meant by this statement.

Accordingly, claims 8 and 9 are not unpatentable over Rautila in view of Hitchings.

Applicants traverse the rejection of claim 11 under 35 U.S.C. §103(a) as being unpatentable over Rautila in view of Kumar et al. (U.S. 2002/0143634).

Kumar does not cure the deficiencies previously noted with respect to the rejection of claim 10, upon which claim 11 depends. In addition, Applicant cannot agree that Rautila

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discloses the claim 11 requirement for a cash register associated with the user of mobile terminal 12 upon a goods input device communicating to a payment facility that an order has been made. Where does Rautila disclose a user of mobile terminal 12 being associated with a cash register?

In view of the foregoing, claim 11 is not obvious over Rautila in view of Kumar et al.

Applicants traverse the rejection of claims 12-15 under 35 U.S.C. §103(a) as being unpatentable over Rautila in view of Ramachandran.

In rejecting claim 12, the Office Action acknowledges Rautila fails to disclose a communication device having a music player, a memory, and a processor for controlling downloading of music files to the memory and for transferring the music files to the music player. In rejecting claim 13, the Office Action correctly notes that Rautila fails to disclose a processor programmed to control a second transceiver to request downloading of a given music file from a similar communications device within the range of the second transceiver, i.e., a transceiver having a high data rate over a short range.

As noted, claim 12 is amended to include the limitations of claim 13 and further distinguishes over the applied references by requiring the processor to be programmed to control the high data rate, short-range transceiver to request downloading of a given

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music file at the second higher data rate from a similar communications device within the range of the second transceiver.

Moreover, combining Rautila and Ramachandran does not meet the terms of claim 12 because, as previously discussed with respect to Ramachandran, downloading a music file from ATM 10 to a device inserted into port 18 appears to be in response to a payment being made to the ATM, not because a processor of the mobile device inserted into port 18 has a short-range, high data rate transceiver that requests downloading.

With regard to claim 14, the Examiner is requested to explain how Ramachandran discloses a mobile phone (which is merely inferentially mentioned in the last two words of paragraph [0059] in conjunction with a processor programmed to control a request for permission from ATM 10 to download a given music file from a similar communication device holding a music file in its storage device drive. How is the foregoing disclosed by Ramachandran in FIG. 2 and paragraphs [0044], [0050], [0059]-[0062]? Where do the foregoing portions of Ramachandran disclose a processor programmed to control a mobile phone transceiver to request downloading of music files once authorization is received from ATM 10?

For at least the above-noted reasons, claims 12-15 are not rendered obvious by Rautila in view of Ramachandran.

New claim 16 is dependent upon claim 12 and is allowable claim 12. In addition, new claim 16 requires a filter for enabling only certain music files from the similar communications

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device to be downloaded from the second transceiver into the memory, a feature not apparently disclosed by the art of record and discussed in the sentence bridging pages 5 and 6 of the application as filed.

Claim 17 is in certain respects similar to claim 1 but more positively defines communications between the transceivers, but does not require the second communications device to be of a similar type to the first communications device. Claim 17, however, includes the previously discussed requirements concerning permission and authorization, which are not found in Rautila and which have been discussed with respect to claim 1.

Claim 18 depends on claim 1 and includes steps indicating the transfer is from the first device to the second device in response to the second device receiving authorization for the transfer from the service provider.

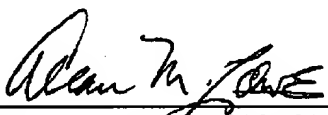
In view of the above remarks, favorable reconsideration and allowance are deemed in order, and such action is respectfully requested.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any required fees not otherwise provided for, including application

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processing, extra claims, and extension fees, to Deposit Account
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Respectfully submitted,
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